

Claims 21, 22, 30, 32-34, and 37-38 have been rejected as unpatentable over the lost interference counts on the grounds of estoppel. The rejected claims differ from the lost interference counts in reciting that the gain fiber has "only one single mode core." The counts do not recite the number of cores in the fiber, but broadly cover any number of cores greater than one. The Grasso '108 patent shows and describes an optical fiber having a double core. Figs. 4 and 5 show the two cores 11 and 12.

Most importantly, the specification of the Grasso et al. patent states that an amplifier of the type being claimed when made from a "single-core" fiber, was "practically useless." (Col. 9, lines 30-40, and col. 10, lines 60-61.) The prior art clearly teaches away from an amplifier with a single core fiber. Authority for the patentability of a claim in this situation is provided in MPEP 2145 XD, citing *In re Hedges*, 783 F.2d 1 038, 228 USPQ 685 (Fed. Cir. 1986). In contrast to the prior art applicants have provided a fiber amplifier which performs its intended function very well with only one single-mode core. The omission of an element and retention of its function is an indicia of patentability. MPEP 2144.04 II B, citing *In re Edge*, 359 F. 2d 896, 149 USPQ 556 (CCPA 1966).

The dependent claims are patentable because they depend from claims which recite "only one single-mode core" and the prior art teaches away from this.

Claims 39-40 have been rejected over the lost count 2. However, these claims also recite a fiber "having only one single-mode core" and the prior art teaches away from such a fiber. Claim 40 is a dependent claim which is patentable for the same reason as parent claim 39.

Claims 41-43 have also been rejected as unpatentable over the lost counts in the interference. These claims also recite that the fiber has "only one single mode core." These claims are patentable for the same reasons discussed above. The prior art teaches away from an amplifier of the type claimed and the omission of an element while retaining its function is an indicia of nonobviousness. Furthermore, these claims define the gain spectrum of the gain fiber and ion filtering means over the wave length bands. The Examiner's position is that the fiber will inherently have the flat or unflat response over the wave lengths over which the fiber in count 1 operates. There is no teaching in the prior art, and not in the Grasso patent, that would suggest this to "the ordinary artisan." It is respectfully submitted that this unobvious aspect of applicants' invention further adds to the patentability of these claims.

Claims 44-50 have been rejected as unpatentable over the lost count of the interference, further in view of the Grasso patent. These claims also recite "only one core" and are patentable over the prior art which teaches away from using only one core for the reasons stated above. These claims further define the gain spectrums in the gain filter and filtering means. The prior art does not suggest this difference in an amplifier of the type claimed. This provides further reason for the patentability of these claims.

Claims 21-50 are patentable over the lost counts of the interference proceedings. There was error in not presenting these claims for examination earlier, as set forth in the reissue declaration. Accordingly, it is respectfully submitted that the rejection of claims 21-50 as being based upon a defective reissue declaration under 35 U.S.C. §251 should be withdrawn.

DOCKET NO.: CORN-0002

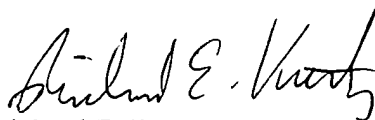
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The claims presented in this reissue declaration are commensurate in scope with the claims of the original patent except that they have been narrowed by reciting a single-mode core and an excitation preventing means. The claims are narrower in all respects than the claims of the original patent. Therefore it is respectfully submitted that a new reissue declaration is not required.

The original patent will be surrendered upon an indication of allowablity of this reissue application.

This application appears to be condition for allowance and such action is respectfully requested.

Respectfully submitted,



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Date: 7-01-02

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